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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,820	11/06/2001	David Vale	A9025	4546
23373 7590 04/28/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
TYSON, MELANIE RUANO				
ART UNIT		PAPER NUMBER		
3773				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/985,820

Applicant(s)

VALE ET AL.

Examiner

Melanie Tyson

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-41 and 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-41 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 10/29/07.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 October 2007 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 29 October 2007 was filed after the mailing date of the Notice of Allowance on 27 September 2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 32, 34, and 39-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilson et al. (6,336,934 B1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Gilson discloses a collapsible filter element (see entire document) comprising a collapsible filter body (105) having a proximal inlet (117) and distal outlet (119) portions and laminated regions (110) as claimed (for example, see Figure 40), and a filter support frame having ribs (111). The regions comprise varying stiffness resulting from different thickness in that an intermediate portion (125) provides a different thickness than the remaining of the filter body.

5. Claims 32, 34, and 39-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniel et al. (5,814,064).

Daniel discloses a collapsible filter element (see entire document) comprising a collapsible filter body (140) having a proximal inlet and distal outlet portions (for example, see Figure 14A) and laminated regions (144) comprising at least two layers (layer above the struts and layer below the struts; for example, see Figure 40), and a filter support frame having ribs (142). The regions comprise varying hardness or stiffness in that one region (148) comprises a tighter woven region of more material, thus comprising thicker material, and the second region (146) comprises a looser woven region of less material.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 33 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilson. Regarding claim 33, it would have been obvious to one having ordinary skill in the art to construct the filter body having a durometer between 60D and 70A Shore hardness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Regarding claim 63, it would have been obvious to one having ordinary skill in the art to construct the filter body having a diameter between 4 mm and 6 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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9. Claims 33 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al. Regarding claim 33, it would have been obvious to one having ordinary skill in the art to construct the filter body having a durometer between 60D and 70A Shore hardness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Regarding claim 63, it would have been obvious to one having ordinary skill in the art to construct the filter body having a diameter between 4 mm and 6 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

10. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being obvious over Gilson et al. in view of Chevillon et al. (5,968,071)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the

application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Gilson discloses a collapsible filter element (see entire document) comprising a collapsible filter body (105) having a proximal inlet (117) and distal outlet (119) portions and laminated regions (110) as claimed (for example, see Figure 40), and a filter support frame having ribs (111). The regions comprise varying stiffness resulting from different thickness in that an intermediate portion (125) provides a different thickness than the remaining of the filter body. Gilson fails to disclose the filter body comprises a first portion with a larger wall thickness than a wall thickness of a second portion.

Chevillon discloses a collapsible filter element (see entire document). Chevillon teaches providing portions of the filter with a larger wall thickness than other wall portions (for example, see Figure 8). It is well within the general knowledge of one having ordinary skill in the art to use a known technique to improve similar devices in the same way. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Gilson's device with regions of larger wall thickness as taught by Chevillon. Doing so would provide the filter with different cross sections, thus enhancing the expanded shape of the filter.

11. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al. in view of Chevillon et al. Daniel discloses a collapsible filter element (see entire document) comprising a collapsible filter body (140) having a proximal inlet and

distal outlet portions (for example, see Figure 14A) and laminated regions (144) comprising at least two layers (layer above the struts and layer below the struts; for example, see Figure 40), and a filter support frame having ribs (142). The regions comprise varying hardness or stiffness in that one region (148) comprises a tighter woven region of more material, thus comprising thicker material, and the second region (146) comprises a looser woven region of less material.

Chevillon discloses a collapsible filter element (see entire document). Chevillon teaches providing portions of the filter with a larger wall thickness than other wall portions (for example, see Figure 8). It is well within the general knowledge of one having ordinary skill in the art to use a known technique to improve similar devices in the same way. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Daniel's device with regions of larger wall thickness as taught by Chevillon. Doing so would provide the filter with different cross sections, thus enhancing the expanded shape of the filter.

Response to Arguments

12. Applicant's arguments filed 02 July 2007 have been fully considered but they are not persuasive. Applicant argues primarily that the prior art applied fails to disclose each and every element as claimed. Examiner respectfully disagrees. Applicant argues that Daniel fails to disclose a filter body including laminated regions comprising at least two layers extending along the length of at least two of the regions, the regions comprising varying hardness or stiffness along the length between the two regions resulting from different thickness or materials of the laminated regions. However, the first layer is

considered the layer underneath the struts and the second layer is considered the layer disposed over the struts. The regions comprise varying hardness or stiffness in that one region (146) comprises a looser woven region of less material and a second region (148) comprises a tighter woven region of more material, thus comprising thicker material. Therefore, the rejection stands.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Thursday 8:30-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
April 14, 2008

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773